

REMARKS

Claims 1, 2, 4-6, and 8-23 are all the claims pending in the application. By this Amendment, Applicant amends claim 19. Claim 19 has been amended to correct a minor typographical error made in the previous Amendment under 37 C.F.R. § 1.111 filed on June 12, 2003. Since such amendments are made to correct minor typographical errors, Applicant respectfully submits that that they do not narrow the scope of the claim and do not raise any Festo implications. In addition, in order to provide more varied protection, claims 21-23 are added.

I. General Remarks

Applicant thanks the Examiner for confirming that the certified copy of the translated priority document was received, and also for returning initialed copies of the Forms PTO/SB/08 A & B (modified) submitted with the Information Disclosure Statements filed on March 25, 2003 and July 10, 2003.

In addition, Applicant thanks the Examiner for withdrawing the previous rejection set forth in the Office Action dated March 12, 2003. However, the Examiner found new bases for rejecting claims 1, 2, 4-6, and 8-20, under § 103.

II. Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 5-6, 9-20, under §103(a) as being unpatentable over US Patent 4,296,069 to Smith et al. (hereinafter Smith) in view of US Patent 6,180,061 to Bogen et al. (hereinafter Bogen) and US Patent 5,059,393 to Quenin et al. (hereinafter Quenin). Claims 4 and 8 are rejected under 103(a) as being unpatentable over Smith in view of Bogen and

Quenin and further in view of US Patent 5,814,277 to Bell et al. (hereinafter Bell). Applicant respectfully traverses these rejections and requests the Examiner *to reconsider* and withdraw the rejections in view of the following comments.

Obviousness in view of Smith, Bogen and Quenin

Claims 1, 5, 9, and 16, are independent. In the rejection of apparatus and method claims 1, 5, 9, and 16, under 35 U.S.C. § 103(a), the Examiner maintains that Bogen teaches an incubator capable of holding the slides at different temperatures, Quenin teaches a bar code reader, and Smith teaches all other limitations of the independent claims 1, 5, 9, and 16. Moreover, the Examiner asserts that combining the three references would have been obvious to allow for more efficient operation.

Smith teaches potentiometric-type slides, used to measure the ionic activity deposited in the incubator 22, whereas colorimetric-type slides, used to measure concentration of specific chemical compound, are deposited in the incubator 24 (col. 3, lines 46-53). Each incubator is specifically designed to store only one type of slides. Thus, each incubator 22 and 24 is incapable of storing two different types of slides. Also, in Smith, the incubators 22 and 24 hold a specific constant temperature, preferably 37°C. (col. 4, line 33). Each incubator 22 and 24 is capable of maintaining only one temperature. Therefore, as acknowledged by the Examiner, Smith fails to teach or suggest an incubator capable of holding different temperatures at the same time (see page 3 of the Office Action).

The Examiner attempts to rely on Bogen as teaching an incubator capable of maintaining different temperatures simultaneously (see page 4 of the Office Action). But the Examiner's interpretation of Bogen is mistaken. Bogen teaches a moving platform slide stainer with heating

elements. Specifically, Bogen teaches a slide frame 510, holding a tissue sample in each slide position 512a-512e. The slide frame 510 has a base 514 and a plurality of heated areas 516, which underlie each of the slide positions 512a-512e (Fig. 6; col. 5, lines 56 to 66). In addition, third and fourth contacts 520 enable temperature sensing of the heated areas via thermocouples also integrally formed in the slide frame base 514 (Fig. 7; col. 6, lines 1 to 4).

Bogen teaches checking the temperature and heating an element to an unspecified temperature. However, there is no suggestion that Bogen's slides are heated to different temperatures. That is, it appears that in Bogen, slides received by the slide frame 510 are heated to the same predetermined temperature, there is no indication as to contrary. Bogen does not teach or suggest differentiating between slides in the slide frame 510 and, as such, if slides are not recognized as being different from one another, they are all heated to the same temperature.

In other words, Bogen's slides are received at a temperature x and are heated to temperature y with the sensor checking to see if temperature y is reached. In that sense, individual heating is beneficial to prevent overheating one slide while heating up another, for example, newly arrived slide. In short, Bogen teaches individually heating up the slides to obtain one predetermined temperature and, as such, it fails to teach or suggest holding different slides at different temperatures.

Quenin only teaches a bar code reader, and thus also fails to cure the deficient teachings of Smith and Bogen with respect to a temperature control means. Accordingly, even if one of ordinary skill in the art were motivated to combine the references as suggested by the Examiner, any such combination would still not include an incubator capable of holding two different temperatures.

In addition, all three references fail to teach or suggest a bar code reader, which detects the position of the chemical analysis element as set forth in claim 1. The Examiner acknowledges that Smith and Bogen fail to teach or suggest a bar code reader as set forth in claim 1. However, the Examiner contends that Quenin's bar code reader is the same as the bar code reader presently claimed (see Pages 4-5 of the Office Action). But the Examiner is misinterpreting and/or misapplying the teachings of the reference. Quenin only states that "The kind of slide that is being supplied to the fluid dispensing station is best determined by a bar code reader (not shown) that reads bar code labels on the slides as they move towards the fluid dispensing station, as is well known in the art." (col. 4, lines 32-36). In short, Quenin only teaches the bar code reader that determines "the kind of slides" and fails to teach or suggest a bar code reader which determines the position of the chemical analysis element. Therefore, Quenin fails to teach or suggest the improved bar code reader with detecting capabilities as set forth in claim 1.

Moreover, there is no motivation to combine the three references in the manner suggested by the Examiner. "[O]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination" In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) (citing ACS Hosp. Sys. v. Montefiore Hosp., 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Winner International Royalty Corporation v. Ching-Rong Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). Conclusory

statements such as common knowledge to one skilled in the art or common sense do not fulfill the agency's obligation. In re Sang Su Lee, 277 F.3d 1338, 1345 - 46, 61 U.S.P.Q.2d 1430, 1438 (Fed. Cir. 2002).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one **“to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”** *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)). **Hindsight has repeatedly been held to be improper and ineffective in supporting an argument of *prima facie* obviousness.** *See, e.g., In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Bond*, 15 USPQ2d 1556 (Fed. Cir. 1990); *In re Laskowski* 10 USPQ2d 1397 (Fed. Cir. 1989).

On the present record, the references simply do not provide the impetus to do what the inventor did. Smith has a pre-heater 84 to raise the temperature of each slide 15 individually (col. 4, lines 42 to 47), the incubators simply hold the slides at a predetermined temperature. As such, one of ordinary skill in the art would not turn to Bogen to replace one pre-heater with a multiple individualized heating elements. Having one element pre-heat each slide is more economical and efficient, because, the incubator need only hold the temperature of the slides

instead of heating them up. In other words, one of ordinary skill in the art faced with a need to maintain slides at a predetermined temperature would not turn to Bogen, a reference which teaches individualized heating of the slides.

For at least the above-noted reasons, independent claim 1 is patentable over Smith in view of Bogen and Quenin. Accordingly, it is appropriate and necessary for the Examiner to withdraw this rejection of independent claim 1. In addition, claims 5, 9, and 16, are patentable for at least similar reasons. Finally, claims 2, 6, 10-15, and 17-20, are patentable at least by virtue of their dependency on the independent claims 1, 5, 9, and 20.

Obviousness in view of Smith, Bogen, Quenin and Bell

Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, Bogen, and Quenin, in view of Bell. The Examiner's careful reconsideration is requested in view of the following comments traversing the rejection. As set forth above, Smith, Bogen and Quenin do not teach or suggest all the elements as set forth in independent claims 1, 5, 9, and 16. Bell is relied upon only for its teaching of automated dilution. Clearly, Bell does not compensate for the above-identified deficiencies of Smith, Bogen and Quenin. Together, the combined teachings of these references would not have (and could not have) led one of ordinary skill in the art to have achieved the subject matter of claims 1 and 5. Since claims 4 and 8 are dependent upon claims 1 and 5, respectively, they are patentable at least by virtue of their dependency.

III. Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the